UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,018	03/31/2004	Jason Urbanski	8627-373 (PA-5270-CIP2)	5526

48003 7590 02/25/2009

BRINKS HOFER GILSON & LIONE/CHICAGO/COOK
PO BOX 10395
CHICAGO, IL 60610

EXAMINER	
PHILOGENE, PEDRO	

ART UNIT	PAPER NUMBER
3733	

MAIL DATE	DELIVERY MODE
02/25/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/814,018	URBANSKI ET AL.	
	Examiner	Art Unit	
	Pedro Philogene	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/15/08 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1,4-19,21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle et al. (6,695,813) in view of Cathcart et al. (5,681,347) in view of Gold et al. (4,636,346) in view of Hillstead (5,098,440).

With respect to claims 1, 21, Boyle et al., disclose a medical grasping device comprising: an elongate control member (18,520) having an atraumatic distal tip section, as best seen in FIG.1, and a proximal end portion; the elongate control member further including a grasping portion (14,16,530) proximal the distal tip section; an outer sheath (46,48) with a passageway therethrough, as best seen in FIG.2, surrounding the elongate control member and relatively movable with respect thereto.

Although Boyle et al teach of a control assembly, as set forth in column 24, lines 19-45, it is noted that Boyle et al., did not teach of a control assembly as claimed by applicant. However, in a similar art, Cathcart et al., evidences such a control assembly to enable the control deployment and displacement of a device.

Therefore, given the teaching of Cathcart et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the control assembly, as taught by Cathcart et al, in the device of Boyle et al., to urge the medical grasping device from a retracted to an expanded position.

Furthermore the prior art teaches of an elongated member, but is silent as to the material used to make the elongate control member. The claimed phrase "the elongate control member being formed for low elongation or is comprised of a low elongation material for low elongation or high elongation" is being treated as a product by process limitation. As set forth in the MPEP 2113, product by process claims are not limited to the manipulations of the recited steps, only to the structure implied by the steps. Thus, even though the prior art is silent as to the process used to make the elongate control member, it appears that the product in the prior art would be the same or similar as that claimed.

In addition, it is noted that the above combination of references did not teach of an elongate control member comprising a low elongation material section and a high elongation material section, the low elongation material section continuously between the proximal end portion and the atraumatic distal section; as claimed by applicant. However, in similar art, Gold et al, column 2, lines 33-57, column 7, lines 17-38,

provides the evidences of the use of an elongate member comprising a low elongation material section and a high elongation material section, the low elongation material section continuously between the proximal end portion and the atraumatic distal section to provide lateral support and avoid kinking or buckling and to enable the user to more easily focus on manipulations needed to maneuver the tip portion through the cardiovascular system.

Therefore, given the teaching of Gold, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Boyle/ Cathcart , as taught by Gold et al, to provide lateral support and avoid kinking or buckling and to enable the user to more easily focus on manipulations needed to maneuver the tip portion through the cardiovascular system.

With respect to claims 4-7, 22-24, the above combination of references teaches all the limitations, the outer sheath being flexible and kink-resistant, as set forth in column 11, lines 42-67, column 12, lines 1-33, the atraumatic distal tip section tapers to a blunt and rounded tip; as best seen at the end of the control member 18, the control assembly including an actuation section that is grippable for reciprocal movement along the handle, as set forth in column 6, lines 3-25 of Cathcart et al., and a connecting block (25) as set forth in column 6, lines 3-25 of Cathcart et al. The low and high elongations; as set forth in column 2, lines 33-57, column 7, lines 17-38 of Gold et al.

With respect to claims 8-19, it is noted that the above combination of references teaches all the limitations, except for wire loops that are substantially circular upon full deployment, as claimed by applicant. However, in a similar art, Hillstead evidences the

use of wire loops that are circular upon full deployment and having side sections that overlap and touch the vessel wall, the loops are capable of overlapping with adjacent ones and are capable of joining with the elongated control member and self deploy transversely upon emerging from the distal end, to engage the object to be retrieved with a greater force.

Therefore, given the teaching of Hillstead, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to incorporate the design of the grasping device of Hillstead in the grasping device of Boyle/Cathcart et al./Gold et a. to engage the object to be retrieved with a greater force.

Claims 2, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle et al. in view of Cathcart et al. in view of Gold et al. in view of Hillstead in view of Braunschweiler et al. (5,484,444).

Furthermore, it is noted that the above combination of references did not teach of an elongated control member that is a flexible cannula defining a lumen extending threthrough into which a guide wire is receivable and movable with respect thereto; as claimed by applicant. However, in a similar art, Braunschweiler et al evidence the use of such an elongated member with cannula and guide wire to ensure that reliable operation is achieved and therefore guaranteed the greatest possible operational reliability.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Boyle/cathcart et al/Gold et

al/Hillstead, as taught by Braunschweiler et al., to ensure that reliable operation is achieved and therefore guaranteed the greatest possible operational reliability.

Response to Amendment

Applicant's arguments filed 12/15/08 have been fully considered but they are not persuasive. The examiner agrees with applicant that Bai's reference did not disclose a low elongation section and a high elongation material section, the low elongation material section extending continuously between the proximal end portion and the atraumatic distal tip section, as claimed by applicant. However, Gold et al provide the evidences of the use of an elongate control member comprising a low elongation section and a high elongation material section, the low elongation material section extending continuously between the proximal end portion and the atraumatic distal tip section. Therefore, the use of an elongate member having high and low elongation materials is old and well known in the art; as taught by Gold et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4,898,591 2-1990 Jang et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/
Primary Examiner, Art Unit 3733
February 23, 2009